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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,409

09/05/2003

Francis D. D'Aguanno

P 25,784-A USA

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23307 7590 04/23/2007  
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EXAMINER

CHIN, RANDALL E

ART UNIT

PAPER NUMBER

1744

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/656,409

Applicant(s)

D'AGUANNO, FRANCIS D.

Examiner

Randall Chin

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 9 and 18-20 is/are allowed.  
6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 5-8, 14 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, lines 3-4, the recitation that the first inner side and second inner side is "non-planar surface" constitutes new matter and is not originally supported.

Furthermore, the first inner side and second inner side could even be considered **planar**, to an extent viewing Figs. 1b or 3. Accordingly, there is no exact measure as to what constitutes "planar" and "non-planar". In any case, such phrases constitute new matter and are even indefinite and inaccurate since the scope of the claims cannot clearly and accurately be ascertained.

Claim 1, line 13, the recitation that respective contours of said first and second inner sides "intermeshing" to align said first and second sections constitutes new matter since the term "intermeshing"

3. Claims 10-13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, line 16, the recitation "...to limit pivoting from said closed position..." makes the scope of the claim unclear since such recitation makes it appear that there can be **some further pivoting** taking place when in the closed position, which would be inaccurate.

As for claim 16, viewing Fig. 1b, it does not appear that the blade is tapered from a distal point "**proximally**" to the connection point (emphasis added) rendering confusion.

Claim 17, lines 2 and 3, the connection point" (both occurrences) lacks proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiting 2,106,584 (hereinafter Whiting).

With respect to claim 3, the patent to Whiting discloses a foldable hand tool (Fig. 1) having an open position (Fig. 1) and a closed position (Fig. 6), comprising a first

section 5 having a first inner side, a second section 6 having a second inner side, and a connector section at 4, 7, 8, said connector section connected pivotably to said first section 5 at a first connection point 7, and said connector section connected pivotably to said second section 6 at a second connection point 8, wherein said first connection point and said second connection point are spaced from one another (Fig. 1) and positioned such that said first inner side of said first section is capable of contacting said second inner side of said second section when said tool is in the closed position (Fig. 6), an "alignment member" at 4 (i.e., the **curved, domed-shaped part** around the pin, rivet 4 in Fig. 3) affixed (**at least indirectly to second section 6**) to one of said first and second sections, and a recess in the other of said one of said first and second sections (i.e., first section 5 in Fig. 3), wherein said recess cooperates with said alignment member to assure proper alignment (Fig. 6) of said first section and said second section when the device is in the closed position. **See final configuration of "alignment member" and "recess" where pin, rivet 4 is in Fig. 6.**

As for claim 4, said alignment member and said recess are deemed cylindrical in shape (Figs. 3 and 6).

6. Claims 1, 2, 5, 7 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Palamara 4,482,263 (hereinafter Palamara).

With respect to claim 1, the patent to Palamara discloses a foldable hand tool (Fig. 1) having an open position (Fig. 1) and a closed position (Fig. 3), comprising a first section 16 having a first inner side that is "contoured", a second section 17 having a

second inner side that is also "contoured", said second inner side being "contoured" complementarily to said first inner side, and a connector section at hinge 15 connected pivotably to said first section 16 at a first connection point O1, and said connector section at 15 connected pivotably to said second section 17 at a second connection point O2, wherein said first connection point and said second connection point are spaced from one another (Fig. 1) and positioned such that substantially all of said first inner side of said first section contacts said second inner side of said second section when said tool is in the closed position (Fig. 3), respective contours of said first and second inner sides "intermeshing" (Fig. 3) to align said first and said second sections as the tool is moved into the closed position.

As for claim 2, a protruding member defined by brush 12 is affixed to the first section 16.

As for claim 5 reciting that the tool is a device for cleaning and reconditioning grooves on a golf club head, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As for claim 7, said protruding member 12 is completely encapsulated (i.e., in trough 13) in the closed position (Fig. 3).

As well as claim 14 is understood, said first 16, second 17, and connector 15 sections are configured to limit pivoting from said closed position (Fig. 3), in which said

first and second sections are substantially parallel, to an open position in which said first and second sections are aligned to form a straight handle (Figs. 1 and 2).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palamara.

As for said first section and said second section each being approximately 2 inches in length (if not already), it would have been obvious to one of ordinary skill in the art to have modified Palamara's first and second sections to be of such a length in order to be sufficiently graspable by a user without slippage during manipulation.

9. Claims 1, 2, 5, 8, 10, 11, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Warren 416,526 (hereinafter Warren).

With respect to claim 1, the patent to Warren discloses a foldable hand tool having an open position (Fig. 1) and a closed position (Fig. 2), comprising a first section A having a first inner side that is "contoured", a second section C having a second inner side that is also "contoured", said second inner side being "contoured" complementarily to said first inner side (Fig. 3), and a connector section connected pivotably to said first

section at a first connection point O, and said connector section connected pivotably to said second section at a second connection point O, wherein said first connection point and said second connection point are spaced from one another (Figs. 1-3) and positioned such that substantially all of said first inner side of said first section contacts said second inner side of said second section when said tool is in the closed position (Fig. 3), respective contours of said first and second inner sides "intermeshing" (at b, e in Figs. 2 and 3; p. 1, lines 77-84) to align said first and said second sections as the tool is moved into the closed position.

As for claim 2, there is a protruding member comprising an arm or blade B.

As for claim 5 reciting that the tool is a device for cleaning and reconditioning grooves on a golf club head, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As for claim 8, the protruding member B comprises a blade.

As well as claim 14 is understood, said first, second, and connector sections are configured to limit pivoting from said closed position (Fig. 3), in which said first and second sections are substantially parallel, to an open position in which said first and second sections are capable of being aligned to form a straight handle (Fig. 1).

As well as claim 10 is understood, the patent to Warren discloses a foldable hand tool (Figs. 1-3), said tool having an open position (Fig. 1) and a closed position (Fig. 2), said tool comprising a first section A having a first inner side, a second section C having



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a second inner side, an arm or rigid protruding member B affixed to said first section A, a recess or slot D disposed in said second section C and configured to receive said protruding member 12 (Fig. 2) when said tool is in said closed position, and a connector section pivotably connecting said first section to said second section, said connector section being connected pivotably to said first section A at a first "pin" O opposite said protruding member, said connector section further being connected pivotably to said second section at a second "pin" O opposite said slot, wherein said first "pin" O and said second "pin" O are spaced from one another and positioned such that said first inner side of said first section contacts said second inner side of said second section when said tool is in the closed position (Fig. 2), and wherein said first, second and connector sections are configured to limit pivoting from said closed position, in which said first and second sections are capable of being "substantially parallel" (Fig. 1), to an open position in which said first and second sections are capable of being aligned to form a straight handle (Fig. 1).

As for cleaning grooves of golf clubs, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As for claim 11, said protruding member comprises an arm or blade B.

As well as claim 16 is understood, the blade B is deemed tapered from a distal point disposed proximally to the connection point on the first section A, to a proximal end disposed distally to the connection point on the first section A.

As well as claim 17 is understood, the blade B is tapered from a distal point disposed proximally to the connection point on the first section, to a proximal end disposed distally to the connection point on the first section (see claim objection above).

10. Claims 6, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren.

As for claim 12, Warren teaches a closed position of the tool in Fig. 2. When the tool is closed an "alignment member" a affixed to first section A which cooperates with a back of blade, wherein both of the recess and said alignment member extend in a direction perpendicular to a plane in which said first and second sections pivot. It is the position of the Examiner that one skilled in the art would find it obvious to provide for a recess being configured to intermesh with said alignment member to assure proper and secure alignment of said first section and said second section in said plane to ensure receipt of said rigid protruding member by said slot when the tool is in the closed position (already shown in Fig. 2). Such arrangement is already suggested by Warren at a different location where a pin or "alignment member" b cooperates with recess e (Figs. 2 and 3).

As for claim 13, accordingly, the pin and alignment member are cylindrical in shape, and said alignment member is capable of being seated, at least partially, into said recess when said tool is closed.

As for claim 15, each of said recess and said alignment member is uniform in transverse cross-section along the direction in which it extends.

As for said first section and said second section each being approximately 2 inches in length (if not already), it would have been obvious to one of ordinary skill in the art to have modified Warren's first and second sections to be of such a length in order to be sufficiently graspable by a user without slippage during manipulation.

#### ***Allowable Subject Matter***

11. Claims 9 and 18-20 are allowed.

#### ***Conclusion***

12. To the extent that Applicant's arguments pertain to Whiting, claim 3, now amended in independent form (and claim 4 which depends on claim 3) have now been rejected by Whiting as explained above. Whiting teaches an alignment member and recess member as specifically explained in the above art rejection to Whiting.

Applicant's arguments relating to claims 1, 2, 5, 7 and 8 are now deemed moot in view of such amendment to independent claims 1 and 3 but with respect to claim 1 are deemed adequately addressed above.

Similarly, with respect to Palamara, Applicant's arguments pertaining to claim 10 are now deemed moot in view of the new grounds of rejection necessitated by amendment. Claims 1, 2, 5-7 and 14 are now rejected based upon Palamara, and as clearly set forth above.

Similarly, with respect to Warren, Applicant's arguments pertaining to claims 10-13 are now deemed moot in view of the new grounds of rejection necessitated by amendment. Claims 1, 2, 5, 8, 10, 11, 14, 16 and 17 are now rejected based upon Warren, and as clearly set forth above. As already clearly explained in the above rejections to Warren, Warren teaches a rigid protruding member, as well said first, second and connector sections are configured to limit pivoting from said closed position, in which said first and second sections are capable of being "substantially parallel" (Fig. 1), to an open position in which said first and second sections are capable of being aligned to form a straight handle (Fig. 1).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

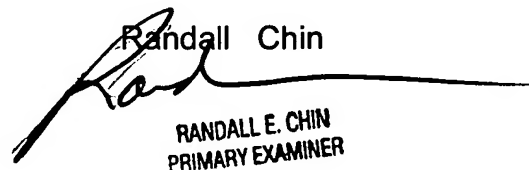
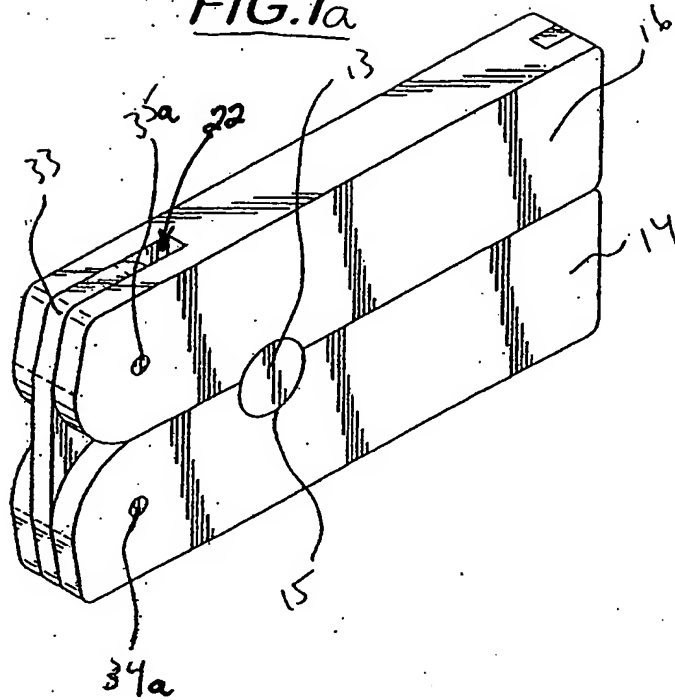
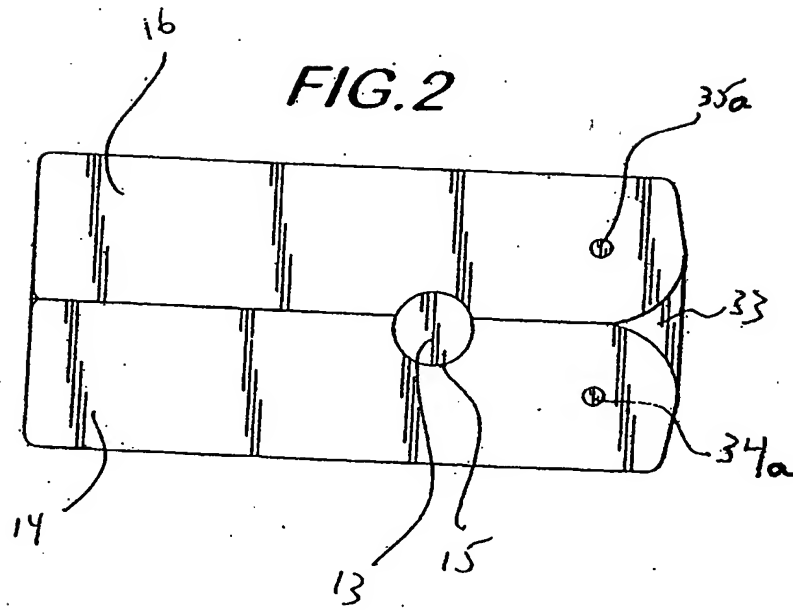
  
RANDALL E. CHIN  
PRIMARY EXAMINER

FIG. 1a



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pe



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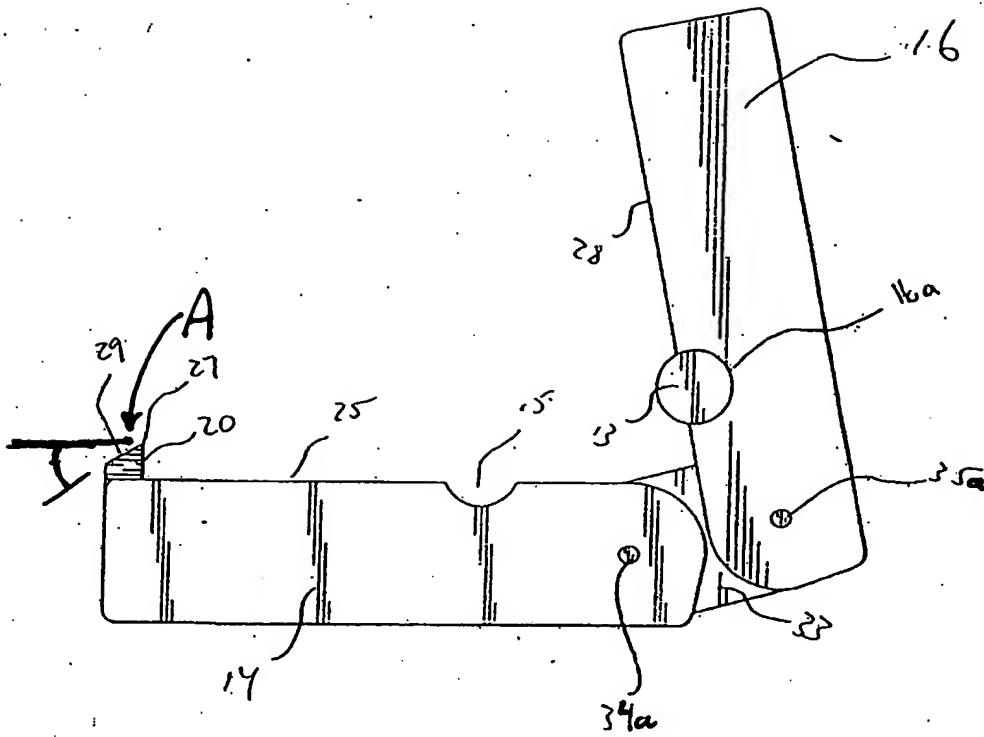


Fig. 3